IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/685,192

Filing Date: 10/14/2003

Applicant(s):   Duncan L. Mewherter, Amy D. Travis, Koah-Hsing Wang
and Robert C. Weir

Entitled: RETRIEVING SLIDE SHOW CONTENT FROM
PRESENTATION DOCUMENTS

Examiner: Debrow, James J.

Group Art Unit: 2176

Attorney Docket No.:   LOT920030025US1 (7321-010U)

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

    This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the

EXAMINER'S ANSWER dated February 16, 2012 (the "Examiner's Answer").

The Examiner's response to Appellants' arguments submitted in the Appeal Brief

of November 23, 2011 (the "Appeal Brief"), raises additional issues and

underscores the factual and legal shortcomings in the Examiner's rejection. In

response, Appellants rely upon the arguments presented in the Appeal Brief, and the arguments set forth below.

THE REJECTION OF CLAIM 16 THROUGH 22 UNDER 35 U.S.C. § 101

At pages 5 through 7 of the Appeal Brief, Appellants argued that the overwhelming position of the Honorable Board is to consider a "computer usable storage medium" to be statutory while merely a "computer usable medium" to be potentially non-statutory when the specification does not preclude and expressly references transitory media such as a signal. Specifically, Appellants stated in part:

> Specifically, in Ex Parte Dureau the Honorable Board found that the recitation in a computer program product claim of a "computer readable storage medium" as a opposed to a "computer readable medium" necessarily excludes a signal.[1] More to the point, in just the past few months, in Ex Parte Bash[2] the Honorable Board not only found the recitation of "computer readable storage medium" to recite statutory subject matter, but the Honorable Board did so observing that the specification in Ex Parte Bash distinguished storage devices from signals as tow different types of computer readable media.[3]

In response, at pages 20 and 21, Examiner takes great pains to distinguish the holdings of Ex Parte Dureau and Ex Parte Bash from the instant case. In particular, Examiner argues that in Ex Parte Dureau the specification distinguished

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[1] Id. at *2 ("We agree with Appellant that the amended claim is statutory because it is now directed to a tangible computer readable *storage* medium, and not to an intangible signal.")
[2] Ex Parte Bash (2010 WL 5199590, Appeal No. 2009-007202)
[3] Id. at *2 ("The portion of Appellants' Specification mentioned by the Examiner (Ans. 3) describes storage devices and signals as two different types of computer readable media. Spec. 37:6-12. The claims, however, are limited to storage media, and thus do not encompass signals.")

a "storage medium" from a "transmission medium" and in <u>Ex Parte Bash</u>, the claim recited a tangible computer readable storage medium.

However, Appellants' claim 16 recites a computer usable storage medium and Appellants' specification does not mention any form of transitory media. To wit, page 11 of Appellants' specification recites:

> The present invention can be realized in hardware, software, or a combination of hardware and software. An implementation of the method and system of the present invention can be realized in a centralized fashion in one computer system, or in a distributed fashion where different elements are spread across several interconnected computer systems. Any kind of computer system, or other apparatus adapted for carrying out the methods described herein, is suited to perform the functions described herein.
>
> A typical combination of hardware and software could be a general purpose computer system with a computer program that, when being loaded and executed, controls the computer system such that it carries out the methods described herein. The present invention can also be embedded in a computer program product, which comprises all the features enabling the implementation of the methods described herein, and which, when loaded in a computer system is able to carry out these methods.
>
> Computer program or application in the present context means any expression, in any language, code or notation, of a set of instructions intended to cause a system having an information processing capability to perform a particular function either directly or after either or both of the following a) conversion to another language, code or notation; b) reproduction in a different material form.

Nothing in the foregoing references any sort of non-transitory media, though the recited portion references the notion of a general purpose computer able to load a computer program (inherently from a computer usable storage medium) in order to "carry out the methods" described in the specification.

In any event, the Honorable Board continues to recognize the distinction between computer usable medium and computer usable storage medium in a manner favorable to computer usable storage medium.[4] Accordingly, Appellants request reversal of the rejection of claim 16 under 35 U.S.C. § 101.

THE REJECTION OF CLAIMS 1 AND 5 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

At pages 10 and 11 of the Appeal Brief, Appellants argued that Appellants' specification necessarily taught the placement of the contextual data in proximity to the raster imagery in stating:

> Clearly, the cited claim language in dispute "a text form of the contextual data in proximity to the raster imagery of the slide show " would be considered by the skilled artisan to be the "title linked to the image".

In response, Examiner argued that "linking" is not "placing an item of data near another item data". Examiner disagrees as the technical act of linking text to an image in markup such as HTML is necessarily the same placing text in the form of contextual data in proximity to raster imagery.

THE REJECTION OF CLAIMS 1-9, 12, 14 - 19 AND 22 UNDER 35 U.S.C § 103(A)

Appellants' independent claims 1, 6 and 16 pertain to slide show presentation conversion. Exemplary claim 1 recites

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[4] Ex parte Wei Hu (Appeal No. 2010-000151).

1.   A system for converting slide show presentations for use within non-presentation applications, the system comprising:
    a computing system with at least one processor and memory;
    a slide show produced by a slide show presentation application and stored in a native format; and,
    a slide show conversion process executing in the memory of the computing system and configured for coupling to a non-presentation application and programmed both to extract contextual data from a slide from said slide show in its native format, to convert the slide in said slide show to raster imagery for use in said non-presentation application and to place a text form of the contextual data in proximity to the raster imagery of the slide show.

Integral to claim 1, and also claims 6 and 16 which recite similar operable limitations, is the placement of a text form of contextual data extracted from a slide of a slide show in proximity to raster imagery of the slide show. So much cannot be found in the combination of Erol and Chakraborty.

    Notwithstanding, Examiner argues to the contrary at pages 26 and 27 of the Examiner's Answer. Specifically, Examiner argues in part that Appellants' claim language does not require the placement of a text form of contextual data extracted from a slide of a slide show in proximity to raster imagery of the slide show which Appellants argued was a non-presentation application. Examiner expressly refers to the absence of "non-presentation application" in which the contextual information is placed in proximity to the image. Yet, Appellants contend that the language and the context (no pun intended) of claims 1, 6 and 16 clearly provide that the slide show is converted to raster imagery for use in the non-presentation application and then to place the text form of the contextual data in proximity to

the raster imagery which is understood from the language of the claim to be used in the non-presentation application.

For the reasons set forth in the Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. §§ 101, 112, first paragraph and 103. To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Date: April 16, 2012   Respectfully submitted,

/Steven M. Greenberg/
Steven M. Greenberg
Registration No. 44,725
Customer Number 46321